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Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

60990043-1

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on November 26, 2007

Signature *Colette Angle*

Typed or printed name Colette Angle

Application Number

09/773,054

Filed

1/31/2001

First Named Inventor

B. Michael Eckard

Art Unit

2863

Examiner

Nghiem, M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor. assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96) attorney or agent of record.
Registration number _____ attorney or agent acting under 37 CFR 1.34.Registration number if acting under 37 CFR 1.34 28,464*Larry K. Roberts* Signature

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Typed or printed name

949-250-6008

Telephone number

November 26, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
ECKARD et al.) Art Unit: 2863
Serial No. 09/773,054) Examiner: Nghiem, M.
Filed: 01/31/2001)
For: SPECIAL SERVICE STATION)
MODULE FOR EXTRA SERVICING)
_____)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a request for a pre-appeal brief conference pursuant to the pilot program set out at 1296 Off.Gaz.Pat.Office 67 (July 12, 2005). A notice of appeal from the final rejection of September 26, 2007 (the "final rejection") is being filed herewith. The claims are set out at pages 2-9 of the "Response to Office Action" paper filed July 12, 2007, and the claims at issue are also repeated below.

Claims Rejections - 35 USC 101

Claims 7, 8, 19 and 20 have been finally rejected as being allegedly directed to non-statutory subject matter. This rejection should be withdrawn or reversed, on the grounds that a prima facie case has not been established, and the subject matter is clearly statutory.

Ser. No. 09/773,054

2

60990043-1

The action provides the following reasons in support of the rejection: "The computer program's or instruction code's functionality cannot be realized without a computer-readable medium. Thus the computer program is treated as nonstatutory functional descriptive material. (MPEP 2106(I)."

In the "response to arguments" section at pages 3-4 of the final rejection, the Examiner's position is stated that "according to MPEP 2106(I),

"computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035."

For purposes of this application and rejection, applicants do not disagree with the broad statement of this except from MPEP 2106(I). However, that does not present the entire picture. The next sentence from the same paragraph from this section of the MPEP states "Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions." Applicants submit, that when one contemplates the claimed subject matter as a whole, the claims define statutory inventions.

As noted in MPEP 2106.01(I):

"Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being

Ser. No. 09/773,054

3

60990043-1

claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory." (Emphasis added)

None of the rejected claims is directed as a whole to a computer program or instruction code. Rather, these claims, set out below, are directed to methods for servicing an inkjet printer, and thus are clearly directed to statutory subject matter.

Claims At Issue:

7. (Previously Presented) A method for servicing an inkjet printer including an inkjet printhead with a nozzle plate and a first service module removably installed on the printer, comprising:

identifying a printhead-related service condition not adequately addressed by servicing the printer with the first service module being in an un-worn condition;

providing a second service module with a service function different from the first service module and adapted to address said printhead-related service condition, the second service module removably installable on the printer and with respect to the first service module;

providing a set of instructions for using the second service module with the inkjet printer to the printer user, wherein the step of providing a set of instructions includes providing a set of machine readable printer instruction code for loading into the printer.

Ser. No. 09/773,054

4

60990043-1

8. (Original) The method of claim 7 wherein the printer is controlled by a host computer, and wherein the step of using the set of instructions includes downloading the set of printer instruction code from the host computer.

19. (Previously Presented) A method for servicing an inkjet printer including an inkjet printhead and a removable first service module, comprising:

providing a second service module different from the first service module and adapted to address a printhead-related service condition not adequately addressed by the first service module being in an un-worn condition, the second service module removably installable on the printer and with respect to the first service module;

providing a set of instructions for using the second service module with the inkjet printer to the printer user, wherein the step of providing a set of instructions includes providing a set of machine readable printer instruction code for loading into the printer;

installing the second service module in the printer;

conducting a printhead-related service operation using the second service module.

20. (Previously Presented) A method for servicing an inkjet printer including an inkjet printhead and a removable first service module, comprising:

providing a second service module different from the first service module and adapted to address a printhead-related service condition not adequately addressed by the first service module being in an un-worn condition, the second service module removably installable on the printer and with respect to the first service module;

providing a set of instructions for using the second service module with the inkjet printer to the printer user, wherein the printer is controlled by a host computer, and the step of providing a set of instructions includes downloading the set of printer instruction code from the host computer;

installing the second service module in the printer;

Ser. No. 09/773,054

5

60990043-1

conducting a printhead-related service operation using the second service module.

Because the rational for the final rejection does not contemplate a consideration of the claimed subject matter as a whole, a prima facie case of nonstatutory subject matter under Section 101 has not been established. Moreover, Claims 7, 8, 19 and 20 are drawn to statutory methods for servicing an Inkjet printer. Applicants respectfully submit that the rejection should be withdrawn or reversed, and the case passed to issue.

Respectfully submitted,



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Dated: 26 Nov 2007

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